Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MUNEHIRO NAKATANI,
MASAMICHI SUGIURA,
and
HIDEO MURAMATSU

_____

Appeal No. 1997-3662
Application No. 07/964,342

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ON BRIEF

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Before RUGGIERO, DIXON, and GROSS, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-18, all of the claims pending in the application. An amendment after final rejection filed September 23, 1996, was approved for entry by the Examiner.

The claimed invention relates to a coding system and

method for a facsimile apparatus in which image data is coded by replacing the image data with codewords representing a white or black run-length. Specific codewords among the black and white codewords are combined along with color information to represent color image data. This color image data is transmitted to a receiving side according to a standard black and white mode in the absence of a special color receiving mode at the receiving side.

Claim 1 is illustrative of the invention and reads as follows:

> 1. A coding method for color image data including the steps of:
>
> providing signals including image data on a transmitting side,
>
> coding the image data by replacing the image data with codewords indicative of a white run-length or a black-run length,
>
> representing color information of a color other than white or black by combining specific codewords among said codewords, and
>
> representing image data including color image data for said color other than white or black by only said codewords by combining said coded image data and said color information to be transmitted to a receiving side according to a standard black and white mode in the absence of a special color mode at the receiving side.

The Examiner relies on the following prior art:

Preuss et al. (Preuss) 4,121,259 Oct. 17, 1978

Claims 1-18 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Preuss.[1]

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before

[1]The rejection of claims 1-4 under 35 U.S.C. § 101 as being directed to non-statutory subject matter has been withdrawn by the Examiner as indicated in the Supplemental Examiner's Answer dated March 14, 2000.

us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-18. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill

in

the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part

of complying with the burden of presenting a prima facie case of

obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d

1443, 1444 (Fed. Cir. 1992).

With respect to the 35 U.S.C. § 103 rejection of independent claims 1, 5, 9, 13, and 18, the Examiner relies upon the

run-length coding disclosure of Preuss which uses code words to indicate the run-length of black and white image data, the codewords being subsequently decoded to produce an image in black and white. As the basis for the obviousness rejection,

the Examiner asserts (Answer, pages 2 and 3) the obviousness to the skilled artisan of modifying Preuss to produce colors other than black and white.

In response, Appellants' arguments (Brief, pages 12 and 13) center on the contention that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested in Preuss. In particular, Appellants assert the lack of disclosure in Preuss, which discusses only black and white images, of the representation of color image data by combining specific codewords which are themselves indicative of black and white run-lengths.

After careful review of the Preuss reference, in light of the arguments of record, we are in agreement with Appellants' position as stated in the Brief. We note that the relevant portion of independent claim 1 recites:[2]

> coding the image data by replacing the image data with codewords indicative of a white run-length or a black run-length,
> representing color information of a color other than white or black by combining specific codewords among said codewords, . . .

We find no disclosure in Preuss that would teach the specifics of this claim language. We agree with Appellants that the claimed invention involves more than the mere substitution of one color for another as suggested by the Examiner. Moreover, we find that no suggestion exists in Preuss for combining black and white codewords to produce color image data other than black or white. Further, the Examiner has provided no indication as to how and in what manner the disclosure of Preuss would be modified to arrive at the claimed invention. In our view, the only reason on the record for the skilled artisan to modify Preuss in the manner

[2]Similar recitations appear in each of the other appealed independent claims 5, 9, 13, and 18.

suggested by the Examiner would be through impermissible hindsight reconstruction of Appellants' invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992).

In view of the above discussion, it is our view that, since all of the limitations of the appealed claims are not taught or suggested by the prior art, the Examiner has not established a prima facie case of obviousness. Accordingly, the 35 U.S.C.
§ 103 rejection of independent claims 1, 5, 9, 13, and 18 as well as claims 2-4, 6-8, 10-12, and 14-17 dependent thereon, is not sustained. Therefore, the decision of the Examiner rejecting claims 1-18 is reversed.

REVERSED

JOSEPH F. RUGGIERO Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)

JFR:hh

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